UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,751	06/26/2001	Dale F. McIntyre	83009F-P	1010

7590	03/24/2005	

Milton S. Sales
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER
CHANKONG, DOHM

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| Office Action Summary | Application No. 09/891,751 | Applicant(s) MCINTYRE ET AL. |
| | Examiner Dohm Chankong | Art Unit 2152 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*22 December 2004*</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-7,10-12,19-27,29 and 30* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-7,10-12 and 19-27, 29, 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>*10/06/04*</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1>   This action is in response to Applicant's amendment and remarks, dated 12.22.2004.

Claims 8, 9 and 28 have been cancelled. Claims 4-7, 10-12, 19-27, 29 and 30 are presented for

further examination.

Response to Arguments

2>   Applicant's arguments with respect to claims 4, 7, 10-12, 21 and 29 have been considered

but are moot in view of the new ground(s) of rejection.

3>   Applicant's arguments with respect to claims 5-6, 19, 20 and 23-27 have been fully

considered but are not persuasive.

    Before continuing, a brief summary of the McCoy reference is in order to help

substantiate Examiner's rejections. McCoy is directed towards a biometric identification

system. Fingerprints or facial images of personnel are stored in a database and used as a basis

for comparison. The authentication of the personnel takes place by taking a current image of

their fingerprint or face; features (minutiae) of this particular image are extracted, and an

identifier is created based on these features. The identifier is then compared with the

prestored image of the fingerprint that is stored in the database; if their identifiers match, the

prestored image is transmitted to the client workstation and displayed next to the newly

obtained image on the workstation.

    Applicant is arguing in substance: (a) that there is no identifying a feature within a

digital image; and (b) creating an image identifier and automatically displaying, transmitting or storing a second digital image based on identifying the image content identifier within the second image; and (c) that the present invention is directed towards performing an automated task based on the identification and presence of an identifier in an image, and not a retrieval system as in McCoy.

With regard to (a), as mentioned in the summary, McCoy discloses identifying fingerprint minutiae, the minutiae extracted from a first fingerprint. In this embodiment, McCoy's first fingerprint is analogous to a digital image, and the minutiae are analogous to features identified within the image.

With regard to (b), the extracted minutiae is formed into a content identifier, the identifier being used to locate any matching images in the database. If there is a match, the second matching fingerprint image is transmitted to the client workstation and displayed. Therefore, the matching fingerprint image is analogous to the second image and the extracted minutiae are analogous to the content identifier.

With regard to (c), McCoy discloses that once a match for the fingerprint minutiae is located in the database, the matching fingerprint is automatically transmitted to the workstation and displayed. Therefore, McCoy's automated fingerprint retrieval, transmission and display (on the client workstation) processes are analogous to the automated task based on the identification and presence of the minutiae in the fingerprint image.

Additionally, Applicant stated that the present invention is not directed towards a retrieval system [page 13 «lines 30-32»]. However, Examiner would like to point out that

claim 23 discloses functionality for providing an image icon that identifies a particular image

to be retrieved over a communications network. Thus, claims 23-27 are directed to an

automated retrieval system similar to McCoy. McCoy discloses providing an image icon of

the fingerprint, utilizing the image icon to search for a full fingerprint stored on the database,

and subsequently returning the matching fingerprint over a network.

Claim Rejections - 35 USC § 102

4>   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5>   Claims 4-7, 10, 12, 19-22 and 29-30 are rejected under 35 U.S.C § 102(e) as being

anticipated by Lloyd-Jones et al, U.S Patent Publication No. 2002/0055955 A1 ["Lloyd"].

6>   As to claim 4, Lloyd discloses a method for automatically forwarding a digital media

file by a first party to a second party over a communication network, said digital media file

having at least one digital image file and a digital information file, comprising the steps of:

analyzing a digital image media file for determining if an image content identifier is

present, said image content identifier having an associated electronic address [0031, 0039

where: "Jenny" metadata is related to Jenny's email address]; and

automatically forwarding said digital image to said electronic address over said

communication network if said image content identifier is present [0039].

7> As to claim 5, Lloyd discloses a method for identifying images for communication

over a communication network [abstract], comprising the steps of:

displaying a digital image [0031, 0034, 0037, 0038, 0039, 0042];

identifying a feature within said digital image [0031, 0034, 0037, 0038, 0039, 0042];

creating an image content identifier based on said feature [0031, 0034, 0037, 0038, 0039,

0042];

displaying, transmitting or storing a second digital image based on identifying the

image content identifier within said second digital image [0031, 0034, 0037, 0038, 0039, 0042].

8> As to claim 6, McCoy discloses the method according to claim 6, wherein the content

identifier is based on parameters used for face recognition [0042].

9> As to claim 7, Lloyd discloses a method for identifying images for communication

over a communication network [abstract], comprising the steps of:

analyzing a digital image [0034];

identifying a feature within said digital image using a pre-established image content

identifier having an associated electronic address [0038, 0039, 0042];

displaying, transmitting or storing said image based on identifying the

feature within said image [0038, 0039, 0042].

10>   As to claim 10, Lloyd discloses a system for automatically sharing images over a

communication network, comprising:

obtaining at least one image identifier comprising an image content identifier and an

associated electronic address[0031, 0038, 0039, 0042];

analyzing digital images for determining if the said image content identifier

substantially matches a portion of said images [0031, 0038, 0039, 0042 where: a certain image

or person in an image is associated with a content identifier ("Jenny" identifier)]; and

automatically forwarding said images that substantially match said image content

identifier over said communication network to said associated electronic address [0031, 0038,

0039, 0042].

11>   As to claim 12, it does not teach or further define over the limitations recited in claim

10. Therefore, claim 12 is also rejected for the same reasons as set forth in claim 10, <u>supra</u>.

12>   As to claims 19 and 20, as they are computer software products that perform the steps

of the methods of claims 5 and 6 respectively, they do not teach or further define over the

limitations recited in claims 5 and 6. Therefore, claims 19 and 20 are rejected for the same

reasons as set forth in claims 5 and 6, <u>supra</u>.

13>   As to claim 21, as it is a computer software products that perform the steps of the method of claim 4, they do not teach or further define over the limitations recited in claim 4. Therefore, claim 21 is rejected for the same reasons as set forth in claim 4, <u>supra</u>.

14>   As to claim 22, as it is a computer software products that perform the steps of the method of claim 10, it does not teach or further define over the limitations recited in claims 10. Therefore, claim 22 is rejected for the same reasons as set forth in claim 10, <u>supra</u>.

15>   As to claim 29, Lloyd discloses a method for automatically forwarding a digital media file by a first party to a second party over a communication network, said digital media file having at least one digital image file and a digital information file [paragraphs 0014, 0024], comprising the steps of:

analyzing a digital image media file for determining if an image content identifier is present, said image content identifier having an associated electronic address [0031, 0039 where: "Jenny" metadata is related to Jenny's email address];

automatically forwarding said digital image to said electronic address over said communication network if said image content identifier is present [0039]; and

automatically updating said content identifier to reflect a change [0038 where: new icons are generated when there is a change in the image].

16>   As to claim 30, Lloyd discloses a method according to claim 29, wherein said content identifier is the appearance of an individual and said change in appearance [0038].

17>   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18>   Claims 5-6, 19-20, 23 and 24 are rejected under 35 U.S.C § 102(b) as being anticipated by

McCoy et al, U.S Patent No. 6.018.739 ["McCoy"].

19>   As to claim 5, McCoy discloses a method for identifying images for communication

over a communication network [abstract], comprising the steps of:

displaying a digital image [column 8 <lines 28-33>];

identifying a feature within said digital image [column 8 <lines 36-41> where:

a fingerprint is equivalent to a feature in the digital image];

creating an image content identifier based on said feature [column 8 <lines 41-44>

where: the compressed minutiae, image and textual data is comparable to an image content

identifier as it is used by the server to compare the image (fingerprint/face) to stored images

in the database];

displaying, transmitting or storing a second digital image based on identifying the

image content identifier within said second digital image [column 10 <lines 45-53> where the

second digital image is the matching fingerprint].

20>   As to claim 6, McCoy discloses the method according to claim 6, wherein the content

identifier is based on parameters used for face recognition [column 4 <lines 32-36 and 49-58>].

21>   As to claims 19 and 20, as they are computer software products that perform the steps

of the methods of claims 5 and 6 respectively, they do not teach or further define over the

limitations recited in claims 5 and 6. Therefore, claims 19 and 20 are rejected for the same

reasons as set forth in claims 5 and 6, <u>supra</u>.

22>   As to claim 23, McCoy discloses a method for automatically obtaining images from a

third party computer for a user over a communication network, comprising the steps of:

        providing an image icon by a user on a user computer which identifies a particular

type of an image that is to be automatically retrieved [column 4 <lines 45-58> | column 7

<lines 24-30> where: the fingerprint or photograph image (and its extracted minutiae) are

equivalent to an image icon, and they specify the type of matching that is required; for

instance, if an fingerprint is submitted to the server, than any matching fingerprint image

type is requested];

        forwarding said image icon to a remote site over a communication network [Figure 1

<items 12a, 13, 11 | column 3 <lines 1-5> where: the minutiae is forwarded to a remote site to be

used as a matching comparison with the stored fingerprints];

        using said image icon at said remote site for identifying an image in accordance with a

particular type of image [column 3 <lines 8-16> where: the fingerprint stored in the database is

compared with the image icon provided by the user];

forwarding said identified image to said user over a communication network [column

11 <lines 29-39>].

23>   As to claim 24, McCoy discloses the method according to claim 23, wherein said image

icon comprises a facial recognition analysis [column 4 <lines 32-36 and 49-58>].

Claim Rejections - 35 USC § 103

24>   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

25>   Claim 11 is rejected under 35 U.S.C § 103(a) as being unpatentable over Lloyd , in view

of Davis et al, U.S Patent Publication 2002/0001395 ["Davis"].

26>   Lloyd does not explicitly disclose the system wherein said images are forwarded to a

fulfillment provider for providing goods and/or services with respect to said at least one

digital image file.

27>   Davis discloses a system wherein said images are forwarded to a fulfillment provider

for providing goods and/or services with respect to said at least one digital image file [0171,

0172, 0173, 0174]. It would have been obvious to one of ordinary skill in the art to incorporate

Davis' fulfillment provider for providing imaging services to a user in Lloyd's photo system.

One would have been motivated to perform such an implementation to increase the

capability of Lloyd's photography system.

28>   Claims 25 and 27 are rejected under 35 U.S.C § 103(a) as being unpatentable over

McCoy.

29>   As to claim 25, McCoy does not explicitly disclose the method according to claim 23,

wherein said user identifies the remote site wherein said image icon is to be placed, but does

state that the user is signs on to the server with which the user will send the

fingerprint/photograph information [column 3 <lines 25-29>]. Thus, it would have been

obvious to one of ordinary skill in the art that the user identifies the remote site where the

image icons are to be placed by the act of signing on to the server; the remote site must be

identified by the user so the workstation knows where to send the image icons.

30>   As to claim 27, McCoy does not explicitly disclose the method according to claim 25,

wherein said remote site provides consent to have it database of digital images analyzed for

determining if any images can be identified, but does state that the user is granted access to

the image databases by the server [column 3 <lines 25-29>]. It would have been obvious to one

of ordinary skill in the art would have inferred that the user act of signing on and obtaining

access to the server is equivalent in functionality to the remote site providing consent to the

user.

31>   Claim 26 is rejected under 35 U.S.C § 103(a) as being unpatentable over McCoy, in view of Lloyd.

32>   As to claim 26, McCoy does not disclose the method of claim 25 wherein said image icon includes the electronic address of said user where image is to be sent.

33>   Lloyd discloses a method of associating an electronic address to an image icon for the purposes of allowing the image to be disclosed or emailed to only those people that have their email (electronic) address linked to the image's identifier [0031, 0039]. As McCoy suggests including transaction parameters along with the images [McCoy - column 8 <lines 41-44>], it would have obvious to one of ordinary skill in the art to implement Lloyd's electronic address association method into McCoy's image transmission method to enable the destination to be encoded directly into the image. One would have been motivated to perform such an implementation to allow the image to automatically sent to the right addresses.
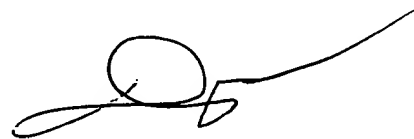
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is (571)272-3942. The examiner can normally be reached on 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glenton Burgess can be reached on (571)272-3949. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information

for unpublished applications is available through Private PAIR only. For more information

about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on

access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-

9197 (toll-free).

DC

Dung C. Dinh
Primary Examiner